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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/009,304	11/18/2003	Tohru Haruna	1858-30	5939
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23117	7590	05/12/2006
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NIXON & VANDERHYE, PC  
901 NORTH GLEBE ROAD, 11TH FLOOR  
ARLINGTON, VA 22203

EXAMINER
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SHIAO, REI TSANG

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 05/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



**This Office action supersedes the previous Office action, dated April 06, 2006.**

### **DETAILED ACTION**

1. This application claims benefit of the foreign application:  
JAPAN 11/168864 with a filing date 06/15/1999. It is also noted that Applicant cannot rely upon the foreign priority papers to overcome the following rejections based on 103(a) and 102(e) because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.
2. The amendment of claims 1-4 and addition of claims 5-6 in the amendment filed on March 03, 2006, is acknowledged. An amendment including addition of claims 7-11 in the amendment filed on March 29, 2006, is also acknowledged. No new matter is found. Claims 1-11 are pending in the application. Since the newly added claims 5-11 are commensurate with the scope of the invention, therefore, claims 1-11 are prosecuted in the case.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 is indefinite because it is recited as a compound claim and use the term "comprising" which is open-ended. A compound claim cannot use open-ended language when defining the parameters of the compound. By deleting the term "comprising" or replacement with the phrase "consisting of", the rejection would be overcome.

The dependent claims 8-11 of claim 7 are also rejected along with claim 7 under 35 U.S.C. 112, second paragraph.

#### ***Responses to Amendment/Arguments***

4. The rejection of claims 1-4 under 35 U.S.C. 112, first or second paragraph, has been overcome in the amendment filed on March 29, 2006.
5. Applicant's arguments regarding the rejection of claims 1-4 under 35 U.S.C. 102(a) or (b) over Takahashi et al. US 6,184,275, Nakamura et al. US 6,153,715, or Nakahara et al. US 4,463,113, filed on March 03, 2006, or March 29, 2006, have been fully considered and they are persuasive. Since the physical characteristics of the instant nucleating agent has not been disclosed in above prior arts, therefore, the rejection of claims 1-4 under 35 U.S.C. 102(a) or (b) is withdrawn herein.
6. Applicant's arguments regarding the rejection of claims 1-4 under 35 U.S.C. 103(a) over Nakamura et al. US 6,153,715, filed on March 03, 2006, or March 29, 2006, have been fully considered but they are not persuasive. Nakamura et al. '715 is 102 (e) reference. The filing date of Nakamura et al. '715 is September 17,

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1998, which is prior to the instant foreign priority date, i.e., June 15, 1999. Moreover, to demonstrate unobviousness, applicants must show unexpected result stemming from the instant compositions over the compositions of Nakamura et al. in form of mechanical advantages of the instant compositions over the compositions of Nakamura et al.

The rejection of claims 1-4 under 35 U.S.C. 103(a) is maintained. The newly added claims 7-11 are drawn to a nucleating agent or compound of formula (I) or (II). The preamble of characteristics of the instant nucleating agents or compounds does not obtain any patentability weight. The instant nucleating agents or compounds of formula (I) or (II), have been disclosed by Nakamura et al., see column 6. Therefore, the newly added dependent claims 5-6, and claims 7-11, are also rejected under 35 U.S.C. 103(a) over Nakamura et al. US 6,153,715.

7. Applicant's arguments regarding the rejection of claims 1-4 under 35 U.S.C. 103(a) over Takahashi et al. US 6,184,275, filed on March 03, 2006, or March 29, 2006, have been fully considered but they are not persuasive. Takahashi et al. '275 is 102 (e) reference.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject

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matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

However, to demonstrate unobviousness, applicants must show unexpected result stemming from the instant compositions over the compositions of Nakamura et al. in form of mechanical advantages of the instant compositions over the compositions of Nakamura et al.

The rejection of claims 1-4 under 35 U.S.C. 103(a) is maintained. The newly added claims 7-11 are drawn to a nucleating agent or compound of formula (I) or (II). The preamble of characteristics of the instant nucleating agents or compounds does not obtain any patentability weight. The instant nucleating agents or compounds of formula (I) or (II), have been disclosed by Takahashi et al., see columns 2-3. Therefore, the newly added dependent claims 5-6, and claims 7-11, are also rejected under 35 U.S.C. 103(a) over Takahashi et al. US 6,184,275.

8. Applicant's arguments regarding the rejection of claims 1-4 under 35 U.S.C. 103(a) over Nakahara et al. US 4,463,113, filed on March 03, 2006, or March 29,

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2006, have been fully considered but they are not persuasive. To demonstrate unobviousness over Nakahara et al. '113, applicants must show unexpected result stemming from the instant compositions over the compositions of Nakahara et al. in form of mechanical advantages of the instant compositions over the compositions of Nakamura et al.

The rejection of claims 1-4 under 35 U.S.C. 103(a) is maintained. The newly added claims 7-11 are drawn to a nucleating agent or compound of formula (I) or (II). The preamble of characteristics of the instant nucleating agents or compounds does not obtain any patentability weight. The instant nucleating agents or compounds of formula (I) or (II), have been disclosed by Nakahara et al., see columns 37-40. Therefore, the newly added dependent claims 5-6, and claims 7-11, are also rejected under 35 U.S.C. 103(a) over Nakahara et al. US 4,463,113.

### ***Double Patenting***

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

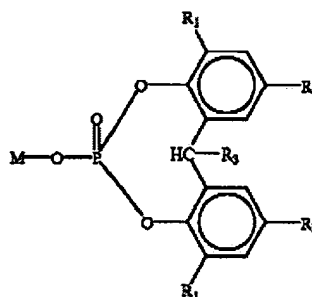
A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1-6 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of Takahashi et al. US 6,184,275.

Applicants claim a crystalline resin compositions comprising a compound phosphoric acid of formula (I) having average aspect ratio of 10 or less.

Takahashi et al. claim a crystalline resin (i.e., polymer) compositions comprising



organic phosphoric acid compounds of formula (I),  
which is 0.01 to 3 parts by weight.

The difference between instant compositions and Takahashi et al. is that the variable n of instant compounds of formula (I) represents 1 or 2, while Takahashi et al. represents 1 at the same position. Takahashi et al. compound No. 1 on column 3, reads on the compound of the instant claim 4.

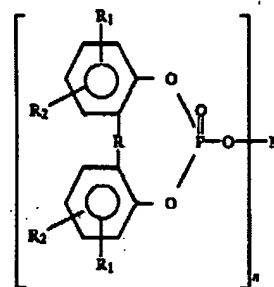


One having ordinary skill in the art would find the claims 1-6 prima facie obvious because one would be motivated to employ the nucleating agent or compositions of Takahashi et al. to obtain instant compositions comprising compounds of formula (I), wherein an average aspect ratio of 10 or less of compounds of formula (I) are incorporated into the instant compositions. To demonstrate unobviousness over Takahashi et al. '275, applicants must show unexpected result stemming from the instant compositions over the compositions of Nakahara et al. in form of mechanical advantages of the instant compositions over the compositions of Nakamura et al.

The motivation to make the claimed nucleating agent or compositions derives from the expectation that the instant claimed compositions from known Takahashi et al. compositions would possess similar activity (i.e., improving strength or transparency of the resin) to that which is claimed in the reference.

11. Claims 7-11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of Nakahara et al. US 4,463,113.

Applicants claim a nucleating agent or compound of formula (I) or (II). The preamble of characteristics of the instant nucleating agents or compounds does not obtain any patentability weight, see claims 7-8 or 10. Dependents claims 8-9 and 11 are drawn to a further limitation of compounds of formula (I), i.e., the variable A.



Nakahara et al. claim a compound of the formula,

wherein the variable R, R<sub>1</sub>, or R<sub>2</sub> independently represents a bond, hydrogen, C<sub>1-8</sub> alkyl or C<sub>1-8</sub> alkylidene, see column 37; the variable n is 1 or 2; and the variable M represents a metal.

The difference between instant compounds and Nakahara et al. is that the variable R<sup>3</sup> of instant compounds of formula (I) represents C1-4 alkylidene group, while Nakahara et al. represents a bond or C1-4 alkylidene group at the same position.

One having ordinary skill in the art would find the claims 7-11 prima facie obvious because one would be motivated to employ the compounds of Nakahara et al. to obtain instant nucleating agents or compounds of formula (I) or (II). To demonstrate unobviousness over Nakahara et al. '113, applicants must show unexpected results stemming from the instant nucleating agent or compounds of Nakahara et al. in form of mechanical advantages of the instant nucleating agent or compounds over the compounds of Nakahara et al.

The motivation to make the claimed nucleating agent or compounds derives from the expectation that the instant claimed nucleating agent or compounds from known Nakahara et al. compounds would possess similar activity (i.e., improving strength or transparency of the resin compositions) to that which is claimed in the reference.

**12. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Shiao whose telephone number is (571) 272-0707. The examiner can normally be reached on 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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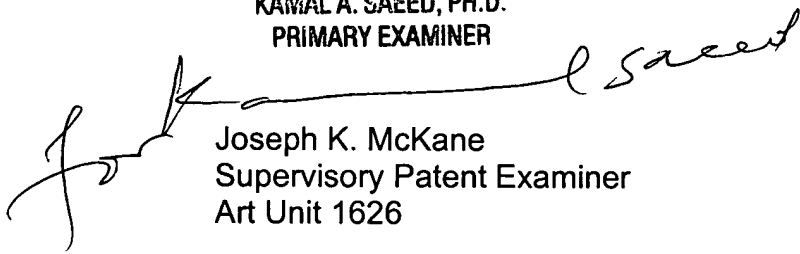
Status information for unpublished applications is available through Private PAIR only.

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Business Center (EBC) at 866-217-9197 (toll-free).

KAMAL A. SAEED, PH.D.  
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read 'K. Saeed', written over a horizontal line.

Joseph K. McKane  
Supervisory Patent Examiner  
Art Unit 1626

A handwritten signature in black ink, appearing to read 'R. Shiao'.

Robert Shiao, Ph.D.  
Patent Examiner  
Art Unit 1626

April 28, 2006